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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,374	12/06/2005	Vladimir Portnykh	Q76716	3625

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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/559,374	PORTNYKH ET AL.	
	Examiner	Art Unit	
	ADAM M. QUELER	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/13/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment and RCE filed 8/4/2008 and IDS filed 8/13/2008.

2. Claims 36-48 are pending in the case. Claims 36 and 43 are independent claims.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/4/2008 has been entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 36-40 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over "MPV Core Specification, Revision 1.01" by OSTA.org, hereinafter OSTA.

Regarding independent claim(s) 36, OSTA teaches:

A single asset element for display comprising audio data and photo data (§6.10);

Reference information (StillWithAudioRef) needed for displaying the audio and photo data above (§6.17). The reference information intended to be used to search the elements (id is the foreign key, idRef is the corresponding reference of the id, §3.1, last paragraph, 5.4). The reference information refers to identification information to identify the asset (idRef).

Location information, intended to be obtained so it could be used, related to the one or more video data and the one or more photo data from the searched elements (lastURL, §5.7, used in §6.11 and §6.7);

Metadata including time information, that is instructions on how to display the data when it is displayed (§6.10, "CaptureDur").

OSTA does not teach checking that the element is a single element comprising audio and photo data. It is recognized that any processing of the element, would require a check to confirm the type of element that it is. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to check that the element (as taught above) is a single element comprising audio and photo data, because that step would be essential to any processing of the element.

OSTA does not teach displaying the audio and photo in accordance with the metadata, including time information. It would have been obvious to one of ordinary skill in the art at the

time of the invention to display the video and photo by use of the meta-data as that was the intended use of the meta-data as described above.

OSTA does not teach the obtaining of reference information and location information, but does teach their use was needed for display as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the both the location and reference information because its use was desired (as described above) and the obtaining would have been necessary in order to use the information.

OSTA does not teach obtaining the audio and photo data with the location information, however, it is recognized that it is necessary to display the data, which is desired as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to extract the video and photo data, because that would be a necessary step in displaying the data, which was desired as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention use the location information for such extraction as would have been in the easiest method of finding the content for extraction since was the last known location of the element (§5.7).

OSTA does not teach searching the asset element using the reference information, however does not teach that is intended to be used to search as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to search the asset element using the reference information because that was the intended use of the reference information.

OSTA does not teach an apparatus for carrying out the above combination. Official Notice is taken that memory under control of processor with software, was a well-known desired

way to implement functionality. It would have been obvious to one of ordinary skill in the art at the time of the invention to embody the above combination on memory under control of processor comprising software enabling the above combination because it was a well-known desired way to implement functionality.

Regarding dependent claim(s) 43, OSTA teaches:

A single asset element for display comprising audio data and photo data (§6.10);

Metadata including reference information (StillWithAudioRef) needed for displaying the audio and photo data above (§6.17). The reference information refers to identification information to identify the asset (idRef).

Reproduction information including time information, that is instructions on how to display the data when it is displayed (§6.10, "CaptureDur").

OSTA is a specification, and discloses varies elements and attributes that intended to be used together to define an asset, but does not specifically disclose the generation of a document including metadata containing all the above elements. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a document containing these elements and attributes, so that they could be extracted and used for display. This would have been desired because the reference is specifically instructions for the generation of such a document (for example, §3.1).

OSTA does not teach displaying the audio and photo in accordance with the metadata, including time information. It would have been obvious to one of ordinary skill in the art at the time of the invention to display the video and photo by use of the meta-data as that was the intended use of the meta-data as described above.

OSTA does not teach the obtaining of reference information, but does teach its use was needed for display as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to obtain the both the location and reference information because its use was desired (as described above) and the obtaining would have been necessary in order to use the information.

OSTA does not teach an apparatus for carrying out the above combination. Official Notice is taken that memory under control of processor with software, was a well-known desired way to implement functionality. It would have been obvious to one of ordinary skill in the art at the time of the invention to embody the above combination on memory under control of processor comprising software enabling the above combination because it was a well-known desired way to implement functionality.

Regarding dependent claim(s) 37, 38, 44, 45, OSTA teaches the metadata is a markup language, MPV (p.9, para. 2).

Regarding dependent claim(s) 39, 48, OSTA teaches information an on attribute of the asset (Recommended properties, p. 109).

Regarding dependent claim(s) 40, OSTA does not teach checking that the element is a single element comprising audio and photo data. It is recognized that any processing of the element, would require a check to confirm the type of element that it is. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to check that the element (as taught above) is a single element comprising audio and photo data, because that step would be essential to any processing of the element.

Regarding dependent claim(s) 46, OSTA teaches the elements are defined by a schema (§2.2, para. 2)

Regarding dependent claim(s) 47, OSTA teaches the element is name StillWithAudio, not AudioWithStill. It would have been obvious to one of ordinary skill in the art at the time of the invention to switch the order to "AudioWithStill", because it still describes the type of asset in question. Also, the difference in the descriptive material describing the element would not result in any patentable difference in how the steps are carried out. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

7. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSTA as applied to claim 36 above, and further in view of Sheldon et al. (7,426,700 B2, 8/16/2008).

Regarding dependent claim(s) 41, OSTA is a specification, and discloses varies elements and attributes that intended to be used together to define an asset, but does not specifically disclose the generation of the code the asset. It would have been obvious to one of ordinary skill in the art at the time of the invention to have generate code containing these elements and attributes (which are for the asset type), so that they could be used for display. This would have been desired because the reference is specifically instructions for the creation of such code (for example, §3.1).

OSTA does not disclose obtaining an icon. Sheldon teaches obtaining a thumbnail rendition according to a type of asset (file type, col. 6, ll. 15-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Sheldon with OSTA as it

would ensure the best possible view for the data (Sheldon, c5.56-58) and because thumbnail was a known predictable manner in which to display an asset.

8. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over OSTA and Sheldon applied to claim 41 above, and further in view of "Synchronized Multimedia Integration Language (SMIL 2.0),W3C Recommendation 07 August 2001" by Jeff Ayars et al.

Regarding dependent claim(s) 42, OSTA and Sheldon do not teach asset transitions. Ayars teaches a user ("author" sentence spanning p. 307-308) defining duration (dur attributes, ex. p. 308) and type (straight cut or left-to-right wipe, p. 308, 2nd full para.). It would have been obvious to one of ordinary skill in the art at the time of the invention to add this timing and transition model to the above combination to enable more presentation options and aesthetic effect (Ayars, spanning para. pp. 307-308), and because Ayers is specifically designed to be added on to other presentation languages (p. 169, para. 2), and because OSTA specifically recommends using use with SMIL for additional features (p. 9 para. 1).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 36-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-59 of copending Application No. 11/415,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because:** every element of the claims is anticipated by the claims of the co-pending application except the co-pending claims are the method that carried out by the apparatus of the instant claim. Official Notice is taken that memory under control of processor with software, was a well-known desired way to implement functionality. It would have been obvious to one of ordinary skill in the art at the time of the invention to embody the above combination on memory under control of processor comprising software enabling the above combination because it was a well-known desired way to implement functionality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 36-39 and 43-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-18, 20-25, 27-28, and 30-33 of copending Application No. 10/948,316 in view of OSTA.

Every element of the claims is anticipated by the claims of the co-pending application except the co-pending claims teach videos displayed in relation to audio, while the instant application teaches photos displayed in relation to audio. OSTA teaches that audio, video, photo and text were both different subclasses of a type of multimedia, a simple media asset (p. 83). It

would have been obvious to one of ordinary skill in the art at the time of the invention to display photo in relation to audio instead of video in relation to any audio, as they were all a form of multimedia of the same type intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 36-39 and 43-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 46-53, 55-63 and 56-68 of copending Application No. 10/949,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Every element of the claims is anticipated by the claims of the co-pending application except the co-pending claims teach text displayed in relation to any multimedia, while the instant application teaches photos displayed in relation to audio. OSTA teaches that audio, video, photo and text were both different subclasses of a type of multimedia, a simple media asset (p. 83). It would have been obvious to one of ordinary skill in the art at the time of the invention to display photos instead of text, in relation to audio instead of any multimedia, as they were all forms of multimedia intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 36-39 and 43-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-35 of copending

Application No. 10/949,253. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Every element of the claims is anticipated by the claims of the co-pending application except the co-pending claims teach photo displayed in relation to any video, while the instant application teaches photos displayed in relation to audio. OSTA teaches that audio, video, photo and text were both different subclasses of a type of multimedia, a simple media asset (p. 83). It would have been obvious to one of ordinary skill in the art at the time of the invention to display photos in relation to audio instead of any video, as they were all forms of multimedia intended to be displayed in conjunction with other multimedia, and would have received the same benefit by displaying them according to a temporal relationship.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

14. Applicant's arguments filed 8/4/2008 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM M. QUELER whose telephone number is (571)272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam M Queler/
Examiner, Art Unit 2178